REMARKS

NEW MATTER

The amendment file by Applicant was objected under 35 USC 132(a) for allegedly containing new matter. The changes which constituted new matter were: the changes to Figures 5a, 7 and 8b. Figure 5a was purported to define angle alpha as being measured between blade and angle theta1. Applicant respectfully disagrees.

Applicant submitted changes to Figures 5a to add in the skive angle α for clarity. See also Applicants' definition of skive angle, paragraph 36 which states: "Skive or skive angle refers to the cutting angle of a knife with respect to the material being cut; the skive angle is measured with respect to the plane of the flat material being cut." See also paragraph 42 that the skive angle is measured relative to plane of the strip. See also Fig. 9. Amended Fig. 5a correctly illustrates the skive angle as relative to the plane of the strip, and which is consistent with the specification. Thus, the addition of the skive angle in Fig 5a is not new matter. Applicant is simply conforming the drawings to the teachings of the specification.

With respect to Figure 8b, Applicant has amended Fig 8b to correct an erroneous and obvious error to the drawing. The Figure as amended now conforms to the specification as cited, above. Applicant has taught in the specification that the cut end of the strip has a skive angle. See e.g., paragraph 49. Applicant is simply conforming the drawings to the teachings of the specification.

The objection to Figure 7 is now moot in light of the cancellation of Figure 7 herewith. For the reasons cited above, it is respectfully requested that these objections be withdrawn.

35 U.S.C. 112, first paragraph

Claims 1-5, 20 and 22 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The office action states: "In general, the details of the cutting action do not enable one of ordinary skill to use the device. The following questions should help Applicant ascertain the specification shortcomings." The office action then recites numerous questions.

35 USC 112, first paragraph requires that specification teach a person skilled in the art how to make and use the claimed invention without undue experimentation. Before any analysis of enablement can occur, it is necessary for the examiner to construe the claims. M.P.E.P. at 2164.04. In order to assert a *prima facie* case of lack of enablement, the Examiner must provide a rational basis as to why the specification does not enable a person skilled in the art how to make and use the invention without undue experimentation. The Examiner must provide some reason why the disclosure is insufficient or why the Examiner does not believe the statements therein. As stated by the court in *In re Marzocchi*, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure". 439 F.2d at 224, 169 USPQ at 370.

The MPEP at 2164.04 further states that the examiner is required to make specific findings of fact, supported by the evidence and then draw conclusions based on these findings of fact. References should be supplied if possible to support a prima facie case of lack of

enablement, but are not always required. However, specific technical reasons are always required. Id.

The office action has failed to interpret the claims and set forth the definitions used to interpret the claims, which is required by MPEP at 2164.04. The office action has failed to set forth specific findings of fact supported by the evidence as well as specific technical reasons as required by MPEP 2164.04. In short, the office action has failed to set forth a reasonable explanation supported by findings of fact and evidence as to why the scope of protection provided by the claims is not adequately enabled by the disclosure. Finally, the office action has not addressed the factors set forth in MPEP 2164.01a, pertaining to the undue experimentation factors.

With respect to claim 1, the office action appears to doubt the existence of the claimed gap distance (d). The Examiner does not believe a gap distance d is maintained while making the cut. Page 3, last line of paragraph 2, Examiner's Office communication of 10/01/2007. Support for this claim limitation may be found in:

paragraph 15: "In another embodiment the step of positioning the cutting edge of the ultrasonic knife includes the step of setting a gap distance (d) above the support approximately slightly less than or equal to the thickness of the cord reinforced component, along the region wherein the support is oriented at the angle θ1. "

paragraph 43 ... As can be seen, the ultrasonic blade (120) is positioned at a slight distance (d) spaced above the anvil (110). That distance creates a gap (d) of approximately 0.0030 inch. This gap (d) is sufficient to allow the cord reinforced tire component (20) to pass under the ultrasonic blade (120) during the cutting procedure. ...

paragraph 44: ..."On the opposite side of the cut, the cords (22) are pressed under the ultrasonic blade (120) and occupy the gap (d) that was provided between the anvil (110) and the blade

(120) for this cutting procedure. As illustrated, three or more cords (22) are shown adjacent to the flat surface (122) of the cutting blade (120). The ability of the cords (22) to be lifted over the blade (120) permits the ultrasonic knife blade (120) to pass through the cords (22) without cutting any of the cords 22."

paragraph 47: ..." It has been found that by transitioning the support (110) from an angle θ1 at one surface (111) to θ2 at the other surface (112) and fixing the gap (2) at the transition location (114), one can predict where the cord (22) impact with the blade edge 121 will occur"

original claim 6, The method of claim 2 further comprises the step of positioning the cutting edge of the ultrasonic knife at a gap distance (d) above the strip slightly less than or slightly to the greater than thickness of the cord reinforced component.

Finally, support for the gap is shown in figures 5a-5c. With respect to Examiner's argument that the Applicant wants it both ways, with a gap being maintained AND the blade penetrating the gap, Applicant respectfully disagrees. Consistent with the specification and the claims, Applicant's gap must be maintained during the cut to allow the cord reinforced tire component (20) to pass under the ultrasonic blade during the cutting procedure.

If the Examiner does not believe the gap distance (d) is maintained during the cut or otherwise exists, the Examiner has the burden to provide contrary evidence that the claimed limitation is not taught by Applicant's specification or to provide further evidence that the claimed gap does not exist when making the cut. According to the MPEP, the examiner should **never** make the determination of enablement based upon personal opinion. See MPEP 2164.05. While it may be the case that the Examiner does not understand how or why the invention works,

35 USC 112 only requires the teachings to enable a person skilled in the art how to make and use the invention without undue experimentation. Further, case law states that "An inventor has no legal requirement to comprehend the scientific principles on which practical effectiveness of his invention rests." Application of Aufhauser, 399 F.2d 275, 283. Applicant has met the enablement standard. Applicant has also described how he believes the invention works in his own language, even though not required. See paragraphs 46 and 47.

The office action further objects to paragraph 17 of the specification which recites "the means for supporting the strip has two surfaces inclined at angles θ1 and θ2 respectively, θ1 is preferably set about 2 degrees less than skive angle α, the angle θ2 is about 2 degrees more than the skive angle α". The office action inquires as to what the angles are measured relative to. The angles θ1 and θ2 are shown in Figure 5a, and are measured relative to the horizontal. As previously stated, the skive angle is also measured relative to the strip. The specification teaches that the anvil has surfaces angled at θ1 and θ2 forming a transition point (paragraph 47) and fixing the gap (d) at the transition point. The Examiner opines that if θ2 is different from the skive angle α, then the gap will constantly change as the blade penetrates, and that if the gap is not maintained, then there is no gap. Applicant respectfully disagrees. As stated in claim 1, the gap is maintained during the cut. The examiner has not set forth evidence to support his position other than his opinion.

Based upon the foregoing, Applicant respectfully requests these rejections be withdrawn.

Claims 1-5 and 20 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully disagrees. The gap of the anvil, and the angles θ1 and θ2 are part of the claimed invention, and therefore should be given patentable

weight. Based upon the foregoing, Applicant respectfully requests these rejections be withdrawn.

35 U.S.C. 103(a)

Claims 1-3 and 20, 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bell et al. '508 in view of Benzing II et al. '101. This rejection is respectfully traversed for the following reasons. The Bell reference teaches cutting through unreinforced rubber sheets and does not teach cutting through reinforced ply. Further, Bell does not teach nor suggest orienting his cutting element at the claimed gap distance (d), which is slightly less than or equal to the thickness of the cord reinforced component. According to Bell's specification at column 8, lines 26-36, the free end of the blade 46 is received or anchored in a pocket of a blade rest, which is received in a channel 12 of the anvil. Therefore, Bell does not teach nor describe that the cutting edge of the cutting element is set at a gap distance (d) above the anvil. The Benzing reference, which is owned by Applicant (and the inventor of this case is also a named inventor), teaches a two-step process for cutting through reinforced ply. First the blade is oriented at an angle Beta in order to position the cutting element between two parallel cords. Then the blade is oriented at angle theta in order to complete the cut. See Abstract of Benzing. While Benzing teaches cutting through reinforced ply without cutting through cord, it requires a two step process. Further, the claimed gap distance (d) is not taught. Thus, the references alone or in combination do not teach nor suggest Applicant's claimed process. As Bell et al. '508 in view of Benzing II et al. '101 fails to establish *prima facie* obviousness of the invention as recited in claims 1-3 and 20, it is respectfully requested that this rejection be withdrawn.

Claims 4 and 5 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Bell et al. '508 in view of Benzing II et al. '101 and further in view of Sergel et al. '601 or

Oldeman '774. This rejection is respectfully traversed for the following reasons. See the reasons, above. Further, neither the Sergel reference nor the Oldeman reference is concerned with cutting reinforced ply. As Bell et al. '508 in view of Benzing II et al. '101 and further in view of Sergel et al. '601 or Oldeman '774 fails to establish *prima facie* obviousness of the invention as recited in claims 4 and 5, it is respectfully requested that this rejection be withdrawn.

Full Faith And Credit

This case was previously allowed twice by Primary Examiner Charles Goodman. In fact the issue fee had been paid. Examiner Goodman withdrew the case from allowance based upon new art cited by the applicant. After Examiner Goodman considered the new art, claims 1-5, 20 and 22 were allowed on 10/19/2006. Examiner Goodman was a Primary Examiner. Examiner Goodman did not raise any new matter rejections nor enablement rejections. On 2/26/2007 new examiner Peterson vacated all indications of allowable subject matter. Examiner Peterson did not cite any additional prior art. Examiner Peterson failed to explain why Primary Examiner Goodman committed clear error. According to the M.P.E.P. at 706.04, "full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the hope of finding something. Amgen, Inc. c. Hoechst Marion Roussel, Inc., 126 F. Supp 2d 69, 139, 57 USPQ2d 1449, 1499-50 (D. Mass. 2001)." Applicant respectfully requests that full faith and credit be given to the previous Primary Examiner's allowance in light of the fact that no additional art was cited nor was there clear error.

In light of this amendment, all of the claims now pending in the subject patent application

are allowable. Thus, the Examiner is respectfully requested to allow all pending claims.

Respectfully submitted,

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